



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

24 AUG 2006

Lisa M.W. Hillman  
MCDONNEL BOEHNEN HULBERT & BERGHOFF  
300 S. Wacker Drive, Suite 3200  
Chicago, IL 60606

In re Application of :  
PROGULSKE-FOX et al :  
U.S. Application No.: 09/980,845 :  
PCT No.: PCT/US00/21340 :  
Int. Filing Date: 04 August 2000 : DECISION  
Priority Date: 06 August 1999 :  
Attorney Docket No.: 00-505-B :  
For: MICROBIAL POLYNUCLEOTIDES :  
EXPRESSED DURING INFECTION OF :  
A HOST :  
:

This is a decision on applicants' "Request for Reconsideration of Petition to Withdraw Holding of Abandonment under 37 CFR §1.181(A); Petition to Withdraw Holding of Abandonment Under 37 CFR 1.183; and Petition for Revival of Abandoned Application Under 37 CFR 1.137(B)" ("Pet.") filed with the United States Designated/Elected Office (DO/EO/US) on 16 June 2006.

**BACKGROUND**

On 04 August 2000, applicants filed international application PCT/US00/21340 claiming priority to a U.S. provisional application filed 06 August 1999. A Demand for the international preliminary examination was not filed. Accordingly, the twenty-month period for paying the basic national fee in the United States expired on 06 April 2001.

On 15 November 2001, applicants filed papers to enter the national stage of PCT/US00/21340 which also included a petition to revive under 37 CFR 1.137(b).

On 21 February 2002, a decision granting applicants' petition under 37 CFR 1.137(b) was mailed.

On 28 February 2002, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a copy of the sequence listing in computer readable form was required. A two-month time period for response was set with extensions of time available pursuant to 37 CFR 1.136(a).

On 08 April 2002, applicants filed a paper copy of the sequence listing and a diskette containing the sequence listing. The Biotechnology Systems Branch of the Scientific and Technical Information Center (STIC) detected errors in the sequence

listing and sent an error report on 21 May 2002.

On 12 June 2002, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that a new CRF sequence listing diskette was required. Applicants were given one month to respond, or any time remaining in the Form PCT/DO/EO/905 with extensions, whichever was longer.

On 01 July 2002, applicants submitted a paper copy of the sequence listing and a diskette containing the sequence listing.

On 03 January 2005, the DO/EO/US mailed a second Form PCT/DO/EO/916 stating that a new CRF sequence listing diskette was required. Applicants were given one month to respond or any time remaining in the Form PCT/DO/EO/905 with extensions, whichever was longer.

On 07 February 2005, applicants submitted a paper copy of the sequence listing and a diskette containing the sequence listing.

On 03 March 2006, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) for failing to respond to the Form PCT/DO/EO/905 mailed 28 February 2002 within the time period set therein.

On 20 March 2006, applicants filed a petition to withdraw the holding of abandonment accompanied by three CD ROMs of the sequence listing.

On 22 March 2006, the STIC processed the CRF CD and found it acceptable.

On 05 May 2006, a decision dismissing applicants' petition to withdraw the holding of abandonment was mailed.

On 16 June 2006, applicants filed the subject petition requesting reconsideration of the prior decision.

### DISCUSSION

Applicants request reconsideration of the prior decision pursuant to 37 CFR 1.181, or in the alternative 37 CFR 1.183, or in the alternative 37 CFR 1.137(b). Applicants requests will be considered in turn.

It is first noted that the prior decision incorrectly stated that the above-captioned application was abandoned on 28 September 2002. This date was the last date for applicants to provide a response to the Form PCT/DO/EO/905 with extensions of time

under 37 CFR 1.136(a). However, the time period to respond to the Form PCT/DO/EO/905 without extensions of time expired on 28 April 2002.

In this case, applicants did not request or pay for an extension of time. As such, the above-captioned application was abandoned on 28 April 2002.

#### **Petition to Withdraw Holding of Abandonment Under 37 CFR 1.181(a)**

In the renewed petition, applicants' argue that the second Form PCT/DO/EO/916 mailed 03 January 2005 precluded any abandonment of the application pursuant to 37 CFR 1.135 because "the Applicant made a *bona fide* attempt to advance the application with a substantially complete reply." Applicants also argue that the Form PCT/DO/EO/916 mailed 03 January 2005 was defective denying applicants the opportunity to correct the sequence listing.

A CRF sequence listing diskette in full compliance with 37 CFR 1.821-1.825 was required by the Form PCT/DO/EO/905 mailed 28 February 2002. The first sequence listing submitted on 08 April 2002 was defective. Applicants were given another chance to submit a proper sequence listing on 12 June 2002. The second sequence listing filed 01 July 2002 was also defective.

Substantial compliance of the requirements of 37 CFR 1.821-1.825 is not considered a *bona fide* response. The Form PCT/DO/EO/916 mailed 03 January 2005 was sent in error and had no effect on the status of the subject application. Therefore, applicants failed to meet the requirements of the Form PCT/DO/EO/905 within the time period given.

For these reasons, applicants' petition under 37 CFR 1.181 is **DISMISSED**.

#### **Petition Under 37 CFR 1.183**

Applicants request a suspension of the regulations under 37 CFR 1.183. Under 37 CFR 1.183, any requirement of the regulations, which is not a requirement of the statutes, may be waived by the Commissioner's designee in an extraordinary situation, when justice so requires and not otherwise provided for. The petition fee of \$400.00 has been charged to Deposit Account No. 13-2490 as authorized.

Applicants argue that the sequence listing filed 24 June 2002 was "substantially and overwhelmingly correct-in-substance" and that "in view of the extremely minor nature of the error, the result of abandonment is draconian."

This argument is unpersuasive. 37 CFR 1.183 is limited by its own terms to

extraordinary situations where justice requires such waiver. In the present case, applicants provided defective sequence listings on two occasions that were not in compliance with 37 CFR 1.821-1.825. This is not the type of extraordinary situation contemplated by the rule that would warrant waiver of a rule no matter what the nature of the defect is. An alternative remedy is available.

It is also noted that the arguments on suspension of the rules regarding the notice mailed 03 January 2005 are not relevant as the subject application was already abandoned at that time.

For the reason discussed above, applicants' petition to suspend the rules under 37 CFR 1.183 is DISMISSED.

#### Petition Under 37 CFR 1.137(b)

A petition to revive an abandoned application on the grounds that the failure to reply was unintentional pursuant to 37 CFR 1.137(b) must be accompanied by: (1) the required reply; (2) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; (3) any terminal disclaimer required pursuant to 37 CFR 1.137(d); and (4) the petition fee as set forth in 37 CFR 1.17(m).

A sequence listing meeting the requirements of 37 CFR 1.821-825 was submitted on 20 March 2006. Applicants' statement is sufficient to meet the requirements of 37 CFR 1.137(b)(3). A terminal disclaimer is not required since the application was filed after 08 June 1995. The \$750.00 petition fee for a small entity has been paid. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

#### DECISION

Applicants' petition to revive under 37 CFR 1.137(b) is GRANTED.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing in accordance with this decision.

*James Thomson*  
James Thomson  
Attorney Advisor  
Office of PCT Legal Administration

Tel.: (571) 272-3302